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MAY 05 2011

OFFICE OF PETITIONS

In re Patent of	:	
Davis et al.	:	
Patent No. 6,054,038	:	
Issue Date: 04/25/2000	:	
Application No.: 09/093001	:	DECISION
Filing or 371(c) Date: 06/08/1998 0	:	ON PETITION
Title of Invention:	:	
PORTABLE, HAND-HELD, IN-SITU	:	
ELECTROCHEMICAL SENSOR FOR	:	
EVALUATING CORROSION AND	:	
ADHESION ON COATED OR UNCOATED	:	
METAL STRUCTURES	:	

This is a decision on the petition under 37 CFR § 1.378(b), to reinstate the above-identified patent, filed March 30, 2011.

The petition is **DISMISSED**.

Any further petition to revive the above-identified application must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

Background

The patent issued April 25, 2000. Patentee could have paid the seven and one half (7½) year maintenance fee between April 25, 2007 and October 25, 2007, without a surcharge, or within the six (6) month grace period between October 26, 2007 and April 25, 2008. Patentee failed to do so; accordingly, the patent became expired on midnight of April 25, 2008.

The present petition

Petitioner, assignee of the present patent, files the present petition and provides that their current patent docketing system is fully automated, but oversight of the system is proffered by an Office Administrator. In the present case, Petitioner provides that the former Office Administrator

charged with oversight of the docketing system, and who would have received any and all maintenance fee reminders on behalf of the Assignee, was terminated for cause during the period that the present patent was to expire. Moreover, Petitioner provides that subsequent reviews by their Firm's current Office Administrator did not disclose the maintenance fee expiration, due to improper entries made by the former Office Administrator.

Petitioner provides further that in the process of a self-imposed audit of their records in March, 2011, the expiration of the patent was discovered.

Petitioner concludes that reasonable care was taken to ensure that payment of the maintenance fee would be made in a timely manner.

Applicable Law, Rules and MPEP

37 CFR 1.378(b) provides that a patent may be reinstated at any time following expiration of the patent for failure to timely pay a maintenance fee. A petition to accept late payment of a maintenance fee, where the delay was unavoidable, must include:

- (A) the required maintenance fee set forth in 37 CFR 1.20(e)-(g);
- (B) the surcharge set forth in 37 CFR 1.20(i)(1); and
- (C) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent.

The required showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly. Furthermore, an adequate showing requires *a statement by all persons with direct knowledge of the cause of the delay*, setting forth the facts as they know them. Copies of all documentary evidence referred to in a statement should be furnished as exhibits to the statement. (Emphasis supplied).

As language in 35 U.S.C. § 41(c)(1) is identical to that in 35 U.S.C. § 133 (i.e., "unavoidable" delay), a late maintenance fee for the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 35 U.S.C. § 133. *See Ray v. Lehman*, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995) (quoting *In re Patent No. 4,409,763*, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988), *aff'd sub nom. Rydeen v. Quigg*, 748 F. Supp. 900, 16 USPQ2d 1876 (D.D.C. 1990), *aff'd*, 937 F.2d 623 (Fed. Cir. 1991) (table), *cert. denied*, 502 U.S. 1075 (1992)). *See* MPEP § 711.03(c) for a general discussion of the "unavoidable" delay standard.

As 35 U.S.C. § 41(c) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 U.S.C. § 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees. *Ray*, 55 F.3d at 609, 34 USPQ2d at 1788. That is, an adequate showing that the delay in payment of the maintenance fee at issue was "unavoidable" within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent.

Id. Thus, where the record fails to disclose that the patentee took reasonable steps, or discloses that the patentee took no steps, to ensure timely payment of the maintenance fee, 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) preclude acceptance of the delayed payment of the maintenance fee under 37 CFR 1.378(b).

In view of the requirement to enumerate the steps taken to ensure timely payment of the maintenance fee, the patentee's lack of knowledge of the need to pay the maintenance fee and the failure to receive the Maintenance Fee Reminder do not constitute unavoidable delay. See Patent No. 4,409,763, *supra*. See also Final Rule entitled "Final Rules for Patent Maintenance Fees," published in the Federal Register at 49 Fed. Reg. 34716, 34722-23 (August 31, 1984), and republished in the Official Gazette at 1046 Off. Gaz. Pat. Office 28, 34 (September 25, 1984). Under the statutes and rules, the Office has no duty to notify patentees of the requirement to pay maintenance fees or to notify patentees when the maintenance fees are due. It is solely the responsibility of the patentee to assure that the maintenance fee is timely paid to prevent expiration of the patent. The lack of knowledge of the requirement to pay a maintenance fee and the failure to receive the Maintenance Fee Reminder will not shift the burden of monitoring the time for paying a maintenance fee from the patentee to the Office. Thus, evidence that despite reasonable care on behalf of the patentee and/or the patentee's agents, and reasonable steps to ensure timely payment, the maintenance fee was unavoidably not paid, could be submitted in support of an argument that the delay in payment was unavoidable.

An error in a docketing system could possibly result in a finding that a delay in payment was unavoidable if it were shown that reasonable care was exercised in designing and operating the system and that the patentee took reasonable steps to ensure that the patent was entered into the system to ensure timely payment of the maintenance fees.

A showing of unavoidable delay will (in addition to the above) require: (1) evidence concerning the procedures in place that should have avoided the error resulting in the delay; (2) evidence concerning the training and experience of the persons responsible for the error; and (3) copies of any applicable docketing records to show that the error was in fact the cause of the delay. See MPEP § 711.03(c)(III)(C)(2).

A delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of "unavoidable" delay, provided it is shown that:

(A) the error was the cause of the delay at issue;

(B) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; and

(C) the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care. See In re Egbers, 6 USPQ2d 1869, 1872 (Comm'r Pat. 1988), *rev'd* on other grounds *sub nom.*, Theodor Groz & Sohne & Ernst Bechert Nadelfabrik KG v. Quigg, 10 USPQ2d 1787 (D.D.C. 1988); In re Katrapat, 6 USPQ2d 1863, 1867-68 (Comm'r Pat. 1988).

Opinion

Petitioner explains that nonpayment of the maintenance fee came about because that their current patent docketing system is fully automated, but oversight of the system is proffered by an Office Administrator. In the present case, Petitioner provides that the former Office Administrator charged with oversight of the docketing system, and who would have received any and all maintenance fee reminders on behalf of the Assignee, was terminated for cause during the period that the present patent was to expire. Moreover, Petitioner provides that subsequent reviews by their Firm's current Office Administrator did not disclose the maintenance fee expiration, due to improper entries made by the former Office Administrator.

Petitioner has not, however, explained the error, or the exact circumstances that caused the error. Petitioner only states that the former Office Administrator charged with oversight of the docketing system, and who would have received any and all maintenance fee reminders on behalf of the Assignee, was terminated for cause during the period that the present patent was to expire. Petitioner has not explained the error putatively made by the former Docket Administrator that was the cause of the delay in paying the maintenance fee. Petitioner must identify the error that was the cause of the delay.

Petitioner must also demonstrate that there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance

Further to this, Petitioner has not provided a statement from the former Office Administrator stating what, if any, error he/she made. As stated *supra*, an adequate showing of unavoidable delay requires a statement by all persons with direct knowledge of the cause of the delay, setting forth the facts as they know them. A statement from the former Office Administrator is required.

Moreover, petitioner has not provided any statement as to the training of the former Office Administrator that would demonstrate that reliance upon the former Office Administrator to properly perform the clerical function was reasonable. What is required is evidence of the training and supervision of the former Office Administrator during his/her employment with Petitioner, from a person with firsthand knowledge of the former Office Administrator's training and experience, i.e. the former Office Administrator's trainer/supervisor, attesting to the training and supervision of the former Office Administrator, such that reliance upon the former Office Administrator to perform the clerical task putatively resulting in the delayed payment of the maintenance fee, was reasonable.

Conclusion

Patentee has failed to demonstrate that the failure to pay the maintenance fee was unavoidable. The petition is dismissed.

Petitioner's current options**I. Petitioner may file a request for reconsideration.**

If reconsideration of this decision is desired, a petition for reconsideration must be filed within TWO (2) MONTHS from the mail date of this decision. The petition for reconsideration should be entitled "Petition for Reconsideration under 37 CFR 1.378(b)." Any petition for

reconsideration of this decision must be accompanied by a non-refundable petition fee of \$400 as set forth in 37 CFR 1.17(h).

After a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Commissioner. Therefore, it is extremely important that petitioner supply any and all relevant information and documentation with his request for reconsideration. The Commissioner's decision will be based solely on the administrative record in existence. Petitioner should remember that it is not enough that the delay was unavoidable; petitioner must prove that the delay was unavoidable. A petition will not be granted if petitioner provides insufficient evidence to 'show' that the delay was unavoidable. Therefore, if a request for reconsideration is filed, it must establish that the entire delay in the submission of the maintenance fee was unavoidable.

II. Petitioner may request a refund of the maintenance fee and surcharge which accompanied the petition.

Petitioner may request a refund of the maintenance fee and surcharge by writing to the Office of Finance, Refund Section, Commissioner for Patents, Washington, DC, 20231. A copy of this decision should accompany petitioner's request.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITIONS
 Director for Patents
 PO Box 1450
 Alexandria, VA 22313-1450

By FAX: (571) 273-0025
 Attn: Office of Petitions

By hand: Customer Service Window
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.

/DLW/

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